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REMARKS/ARGUMENTS

Claims 1 – 30 are in the application. Reconsideration is respectfully requested.

Claim Rejections Under 35 USC §103

All of the independent claims 1, 7, 13, 17, 24, and 27 were rejected as obvious in view of US Patent No. 5,956,053 to Michael. For the following reasons, applicant submits that a proper *prima facie* case of obviousness has not been made, and this rejection should be withdrawn.

As respects claim 1, the Examiner points out that Michael does not teach a reservoir that is configured to be isolated from ambient as the sealing member abuts the printhead, as recited in the final clause of claim 1.

The office action (page 4) then states that (1) there is no opening in the body of the catch basin 150 of Michael, and (2) the catch basin 150 is designed to handle ink and moisture accumulation to maintain a humidified environment. The office action then concludes that “*although Michael’s invention does not explicitly teach the catch basin can be isolated from ambient ...*” one of ordinary skill in the art would conclude from points (1) and (2) above that the Michael catch basin would “*achieve the isolation purpose.*”

On first glance, the rejection grounds as just summarized, appear to state an anticipation rejection under the doctrine of inherency, although the rejection is otherwise framed as one of obviousness. For the sake of efficient prosecution of this application, applicant herein addresses both grounds.

As to the question of inherency, applicant submits that the asserted inherent characteristic of Michael (isolating the catch basin interior or “reservoir” from ambient) cannot be relied upon because, when considered as a whole, the Michael reference makes it clear that the catch basin is indeed vented to ambient. In the Michael embodiment identified by the Examiner (Figs. 4 – 6), applicant notes that, as shown in the detailed views in Figs. 12 and 13, the upper surface of the rim 154 of the catch basin body has a trough, shown as a spiral groove, to define a vent passageway 195 when the catch basin is assembled against the elastomeric part 120 of the device.¹ The vent passageway 195 extends from an entrance port at the catch basin

¹ See Fig. 4 and column 14 lines 24 – 40.

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chamber 156 to an exit port at ambient atmosphere, thus venting the s aling chamber 125 and catch basin to atmosphere.²

Accordingly, there is no question that the Michael disclosure explicitly teaches that the catch basin is *vented* to ambient and, therefore, cannot be read as inherently teaching the catch basin is *isolated* from ambient.

As to the question of whether the explicit teachings of Michael (including the notion of a catch basin/reservoir vented to ambient) would lead one of ordinary skill to modify the Michael device to arrive at what is claimed, applicant submits a *prima facie* case of obviousness has not been made in the office action, and any rejection based upon such a modification of Michael cannot stand, as explained next.

The MPEP, in section 2143, sets forth what is needed for establishing a *prima facie* case of obviousness for rejecting claims under 35 USC § 103. The pertinent portion of that section is reproduced here:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Applicant submits that at least the first of the criteria set forth above has not been met in the present office action. Specifically, nowhere is there shown in the office action where in Michael one would find motivation for doing away with the vent passageways that were designed into each embodiment of Michael. Accordingly, in the absence of such a showing, the rejection of claim 1 and the claims depending therefrom must be withdrawn.

The rationale provided in the office action for rejecting the remaining independent claims 7, 13, 17, 24, and 27 referred to the same grounds as applied in rejecting claim 1. Accordingly, applicant submits that, for the reasons set forth above in connection with claim 1,

² The other described embodiment of Michael also discloses a vented chamber as noted in the text associated with Fig. 15.

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these claims and the claims depending therefrom are not anticipated by n r rendered obvious by Michael.

Conclusion

In view of the foregoing, applicant submits that all of the currently pending claims are in condition for allowance and an early notification to that effect is respectfully requested. If the Examiner has any questions, he is invited to contact applicant's attorney at the below-listed telephone number.

Respectfully submitted,
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